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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/725,394
Filing Date: November 29, 2000
Appellant(s): WHITMYER, WESLEY W.

Todd M. Oberdick and Steven B. Simonis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 23, 2006 appealing from the Office action mailed May 22, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,987,464	SCHNEIDER	11-1999
6,766,305	FUCARILE et al.	7-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,987,464 issued to Eric Schneider (hereinafter "Schneider") and in view of U.S. Patent Number 6,766,305 issued to Lori J. Fucarile et al. (hereinafter "Fucarile").

With respect to claim 1, Schneider discloses a system for automating the recordation of a property transfer comprising:

an Internet server (Figure 8, item 302 and corresponding text);

a communications link between said Internet server and the Internet (Figure 8, item 144 and corresponding text);

at least one database (Figures 11 and 12a, item 350 and corresponding text) containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number (Figures 11 and 12a, item 350 and corresponding text);

software executing on said Internet server for receiving a transfer request

indicative of a transfer of rights to the property (column 15, line 52 - column 16, line 33).

Schneider does not explicitly discloses software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request and for combining the retrieved information record with the retrieved recordation form to generate a document as claimed.

Fucarile discloses claimed software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request and for combining the retrieved information record with the retrieved recordation form to generate a document (col. 8, lines 62 to col. 9, lines 42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Fucarile with the teachings of Schneider to enable the system which can be adapted to hold license records (recordation form) and receive and store access information such as number of accesses, user information and the license server can then generate usage reports that can be used to determine licensing requirements (column 3, lines 62 – 67).

With respect to claims 3 and 8, further to the teachings of above claim 1, Schneider and Fucarile teach at least one database containing a plurality of information records accessible by said Internet server, each information record including an

intellectual property identification number and a jurisdiction identifier (Figures 11 and 12a and corresponding text; Schneider);

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property (92, fig. 4, Schneider).

software executing on said Internet server for transmitting said property transfer request form through the Internet (34, fig. 12, Schneider);

software executing on said Internet server for receiving a reply to said property transfer request form (col. 9, lines 10-22, Fucarile);

software executing on said Internet server for transmitting said transfer document through the Internet (92, fig. 4, Schneider); and

software executing on said Internet server for updating said database containing a plurality of information records (34, fig. 5 and col. 7, lines 38-47, Schneider).

As to claims 2, 4 and 9, further to the rejections of claims 1, 3 and 8 above, Schneider discloses property is intellectual property such as patents, copyrights, and trademarks (col. 16, lines 14-63).

As to claims 5 and 6, further to the rejection of claim 3 above, Schneider discloses software executing on said Internet server for receiving and transmitting an executed transfer document (col. 16, lines 34-64).

As to claim 7, further to the rejection of claim 3 above, Fucarile teaches software executing on said Internet server for transmitting said executed transfer document to a property recordation authority (col. 9, lines 10-22).

As claim 10, further to the rejection of claim 8 above, Schneider discloses software executing on said internet server for retrieving said updated to said database containing a plurality of information records through the internet from a plurality of sources (34, fig. 5 and col. 7, lines 38-47).

(10) Response to Argument

Appellant's arguments regarding the rejection of claims 1 – 10:

Argument A: Neither Schneider nor Fucarile teach, disclose or suggest software executing in the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying the database of recordation forms to retrieve a recordation form corresponding to the transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document (Page 7, Brief).

Argument B: Neither Schneider nor Fucarile teach, disclose or suggest software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property (Page 10, Brief).

Argument C: Neither Schneider nor Fucarile teach, disclose or suggest software executing on the Internet server for generating a property transfer request indicative of a transfer of rights to the property (Page 12, Brief).

Argument D: There is no motivation to combine Schneider with Fucarile (Page 12, Brief).

Examiner's Response to Arguments:

In response to argument A:

The Appellant argues that neither Schneider nor Fucarile teach, disclose or suggest software executing in the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying the database of recordation forms to retrieve a recordation form corresponding to the transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-1]

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood

by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Schneider teaches a method and system for **information delivery (transfer information)** of a computer system. The method includes the steps of storing a first data including a program and potentially reusable data on a storage medium of a computer system. In turn, a second data including control data is subsequently stored on the same storage medium as the first data. The content of the control data is unknown at the time the first data was stored. The control data corresponds to a subset of the potentially reusable data. The program is executed and combines the control data and the potentially reusable data to create on the storage medium of the computer system a third data including newly indexed available information. **Information is delivered by sending a plurality of transmissions** where known data is sent in advance to minimize the subsequent delivery of unknown control data that becomes known based upon a future event.

As technology progresses in the digital age, technology has constantly reinvented new ways of utilizing data by optimizing the space and time necessary for the storage, **transfer,** compilation, and arrangement of information. **Methods of data**

delivery have included the compression and/or ciphering of **data sent** via floppy diskette, compact disc (CD-ROM), or e-mail and by **receiving data from centralized sources such as the Internet, Bulletin Board System (BBS), or other on-line services.** Such is the case in the area of **patents**. In exchange for disclosure of an invention, the issuance of a U.S. Patent is a twenty year grant from the time filed by the government of **a property right to the inventor** to exclude others from making, using, or selling the invention, with the patentee losing rights to the invention upon expiration. The most common use of patent information and an early step in assessing the patentability of an invention is to perform prior art searches of existing patents. To assist patent examiners, the Automated Patent System (APS- search engine) was implemented and by accessing the APS database from a computer, an examiner can select patents for review based on the occurrence of specified words or phases, in particular combinations, in the document. A subscriber performs a query on a web page at a web site on the Internet via the transceiver of a computer system by using a World Wide Web (WWW) browser, which is a program that interprets many different on-line protocols and displays such information received by these protocols in a desired manner to the subscriber. One such protocol called the Hypertext Transfer Protocol (HTTP) is the most common method to access information via the web pages of a Web server on the Internet. Requests for information accessed are sent and received in the form of Hypertext Markup Language (HTML), which is an understood format for the HTTP. Another communications protocol that has been universally accepted as a standard for on-line database searching is called the Z39.50 protocol. The Z39.50

server accepts TCP connections from the transceiver of a computer system and requests to search and retrieve from available databases accessible through the database search engine. When a subscriber requests a patent search at the provider's search page on the Internet, a connection to the correct database is established before a query session can begin. A query is extracted from the parsed HTML form and is passed on from the Z39.50 server to the database search engine for obtaining search results. A program is executed to receive a current delivery of data containing both newly issued patent data and control data.

Fucarile teaches a licensing mechanism allowing for different forms of license for use in an environment of interconnected servers providing content. Fucarile invention comprises both methods and a system for licensing individual content based upon the nature of the use, thus facilitating the distribution of content without a license for non-commercial purposes and content with a license for commercial purposes. The system utilizes a special form placed within the content, the form containing either a legal assertion of the non-commercial nature of the use, or an identification of the licensee and other related data. If the form includes an identification of the licensee, a license server may be contacted to validate the license. Fucarile further teaches a licensing tool or server to generate the appropriate form (recordation form) for insertion within the content. Fucarile's invention includes a system and method for managing access to functionality provided by a software component or plug-in running on a client computer. The steps executed include maintaining a store of license records for software items

that may include programs or modules. Each of the license records includes an identification of a licensee and an associated level of functionality for that licensee. This information is used to define an access policy for the licensee that is used to determine what access is granted to the licensee to the software items. The plug-in can be adapted via the use of a file authentication mechanism to ensure that the content file is not corrupted. In addition, the license form or license server can specify the level of functionality allowed under the license, thus allowing licensing on a module-by-module basis. The license server can be adapted to hold license records and receive and store access information such as number of accesses, user information, machine information and module information. The license server can then generate usage reports that can be used to determine licensing requirements (recordation). The invention further includes a tool for creation of the license form. The tool can be a stand-alone software program delivered to a licensee or a server provided by the licensor and available to the licensee via a communications channel.

In explicit licensed content, the [License . . .] form will contain at least a portion of the encoded information. In order to verify the validity of this form of license, the plug-in causes a request for license validation to be generated based in part on the contents of the [License . . .] form and sent to the authorization server. The authorization server receives the request from the user's system. Authorization server may be the same server as the content server, but in the present example, the authorization server is a separate computer. The authorization server then generates a response dependent upon information in the request and the license database.

Fucarile teaches licensing system same as Intellectual Property system and hence, Fucarile reference is an analogous art same as Instant application. Fucarile discloses in Figure 4 a License Server and License Database and its corresponding text teaches the License form, which will contain at least a portion of the encoded information. Fucarile discloses form similar to instant application.

The teachings of Schneider and Fucarile clearly teaches applicants claimed limitation and the arguments.

In response to argument B:

Schneider's teachings alone teach a method and system for information delivery (transfer information) of a computer system. Information is delivered by sending a plurality of transmissions where known data is sent in advance to minimize the subsequent delivery of unknown control data that becomes known based upon a future event. Methods of data delivery have included the compression and/or ciphering of data sent via floppy diskette, compact disc (CD-ROM), or e-mail and by receiving data from centralized sources such as the Internet, Bulletin Board System (BBS), or other on-line services. Requests for information accessed are sent and received in the form of Hypertext Markup Language (HTML), which is an understood format for the HTTP. Another communications protocol that has been universally accepted as a standard for on-line database searching is called the Z39.50 protocol. The Z39.50 server accepts TCP connections from the transceiver of a computer system and requests to search and retrieve from available databases accessible through the database search engine. When a subscriber requests a patent search at the provider's search page on the

Internet, a connection to the correct database is established before a query session can begin. A query is extracted from the parsed HTML form and is passed on from the Z39.50 server to the database search engine for obtaining search results. A program is executed to receive a current delivery of data containing both newly issued patent data and control data.

In response to argument C:

Fucarile's teachings teach a licensing tool or **server to generate the appropriate form (recordation form)** for insertion within the content. Fucarile's invention includes a system and method for managing access to functionality provided by a software component or plug-in running on a client computer. The steps executed include maintaining a store of license records for software items that may include programs or modules. Each of the license records includes an identification of a licensee and an associated level of functionality for that licensee. This information is used to define an access policy for the licensee that is used to determine what access is granted to the licensee to the software items. The plug-in can be adapted via the use of a file authentication mechanism to ensure that the content file is not corrupted. In addition, the license form or license server can specify the level of functionality allowed under the license, thus allowing licensing on a module-by-module basis. The license server can be adapted to hold license records and receive and store access information such as number of accesses, user information, machine information and module information. **The license server can then generate usage reports that can be used to determine licensing requirements (recordation).** The Fucarile invention further

includes **a tool for creation of the license form**. The tool can be a stand-alone software program delivered to a licensee or a server provided by the licensor and available to the licensee via a communications channel.

In response to argument D:

In response to applicant's argument D that there is no motivation or suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Fucarile with the teachings of Schneider to enable the system which can be adapted to hold license records (recordation form) and receive and store access information such as number of accesses, user information and the license server can then generate usage reports that can be used to determine licensing requirements.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Shahid Alam

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Primary Examiner
Art Unit 2162

November 12, 2006

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